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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,460	06/05/2001	Dan Kikinis	007287.00036	6281
22907 7590 01/29/2009 BANNER & WITCOFF, LTD. 1100 13th STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051				
EXAMINER				
SALCE, JASON P				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/875,460

**Applicant(s)**

KIKINIS, DAN

**Examiner**

Jason P. Salce

**Art Unit**

2421

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,6-11 and 14-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-11,14-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/23/2008 has been entered.

### ***Claim Rejections - 35 USC § 112***

Claims 1 and 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claims 1 and 9 have been amended to recite, "**wherein the EPG includes an indication of which web-enabled cellular phone buttons are appropriate for the EPG**". No support is found in the specification of the instant application for these claim limitations (**or in the provisional applications**).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 6, 9-11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (U.S. Patent Publication Application No. 2005/0028208) in view of Ellis et al. (U.S. Patent No. 6,774,926) in further view of Yoshida (U.S. Patent No. 5,936,611).

Referring to claim 1, Ellis discloses receiving EPG selection entered over the Internet via a remote device having a first video display (**see Paragraphs 0014-0016 and 0092**), wherein the EPG includes preset selections (**see Paragraph 0024**).

Ellis also discloses displaying the EPG on the first video display of the remote device (**see Paragraph 0097**).

Ellis also discloses receiving selections entered over the Internet via the remote device (**see Paragraphs 0097-0100**).

Ellis also discloses storing the EPG selections on a storage device (**see Paragraph 0072 for the remote program guide access device storing the EPG data**).

Ellis also discloses transmitting the EPG selections to be displayed on a second video display associated with a television when requested (**see Paragraph 0016 for making program selections remotely, which will be displayed on the TV**).

Ellis is silent as to the EPG selection being entered via a web-enabled cellular phone.

Ellis (**'926 Patent**) discloses a cellular phone 42 with display 100, wherein the display 100 is used to display and select EPG items (**see Column 7, Lines 18-26 and Column 8, Lines 60-67**).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to combine the systems of Ellis and Ellis (**'926 Patent**) in order to provide a system capable of utilizing a mobile phone having EPG capability as a remote controller, thereby providing the user with extended functionality and control and allowing the user to reserve programs from remote locations. Also note that Ellis (**'926 Patent**) specifically states that an advantage to the system allows the cell phone to access the schedule information and perform various functions, such as searching for programming of interest, establishing favorite programs, setting reminders and setting parental controls (**see Column 1, Lines 40-46 of the '926 Ellis Patent**).

Ellis and Ellis (**'926 Patent**) are silent as to the EPG including an indication of which web-enabled cellular phone buttons are appropriate for the EPG. While Ellis (**'926 Patent**) teaches the use of a web-enabled cellular phone to make EPG selections, neither Ellis reference teaches indicating to the user which buttons can be used for a particular set of functions.

Yoshida discloses an EPG that displays an image of the remote control the viewer is using (**see Figure 7**). The remote control image on the display further provides an indication to the user each key's functionality when a user presses the key

on the remote control (**see Figures 7-9 and Column 6, Line 30 through Column 8, Line 29**).

At the time the invention was made, it would have obvious to a person of ordinary skill in the art, to modify the EPG accessed by a web-enabled cellular phone, as taught by Ellis and Ellis ('**926 Patent**'), using the instructional control keys interface, as taught by Yoshida, for the purpose of allowing a user to easily know the function of the keys even through he/she loses or misplaces the manual for the device (**see Column 2, Lines 55-57 of Yoshida**).

Referring to claims 2 and 3, Ellis discloses storing EPG selections on a broadcast server and set top box (**see Paragraph 0017 and Figure 2**).

Referring to claim 6, Ellis further discloses that the system displays EPG selection on the remote terminal when requested (**see Paragraph 0015**).

Referring to claims 9-11 and 14, see the rejection of claims 1-3 and 6, respectively. In regards to claim 9, further note that Ellis discloses that the EPG can also be displayed on the second video display associated with the television (**see Paragraph 0071**).

Claims 7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (U.S. Patent Publication Application No. 2005/0028208) in view of Ellis et al. (U.S. Patent No. 6,774,926) in further view of Yoshida (U.S. Patent No. 5,936,611) in further view of Cooper et al. (U.S. Patent No. 6,754,904).

Referring to claim 7, Ellis, Ellis (**'926 Patent**) and Yoshida disclose all of the limitations of claim 6, where Ellis (**'926 Patent**) teaches the use of a web-enabled cellular phone in place of a remote control to select television programs in an EPG (**see above**), but are silent as to transmitting the EPG selections over the Internet to multiple web-enabled cellular phones to be displayed concurrently when requested.

Cooper discloses a plurality of client devices that are capable of selecting television programs to view (**see Figure 5**). Cooper further discloses making EPG selection (**see Figure 7 for using the EPG of Figure 6**) and transmitting the selections over the Internet to multiple client devices to be displayed to all users (**concurrently**) while in a chat room (**see Figures 7-11 and Column 2, Lines 45-47 and Column 5, Line 54 through Column 7, Line 59**).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the web-enabled cellular phones, as taught by Ellis, Ellis (**'926 Patent**) and Yoshida, using the chat enabled client devices, as taught by Yoshida, for the purpose of informing a first network user of activity by other network users, thereby allowing users to know what television programs his/her friends are watching (**see Column 2, Lines 39-41 of Cooper**).

Referring to claim 15, see the rejection of claim 7.

Claims 8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (U.S. Patent Publication Application No. 2005/0028208) in view of Ellis et al. (U.S. Patent No. 6,774,926) in further view of Yoshida (U.S. Patent No. 5,936,611) in further view of Terakado et al. (U.S. Patent No. 6,246,441).

Referring to claim 8, Ellis and Ellis ('926 Patent) disclose all of the limitations of claim 6, but are silent as to transmitting one or more programs to be separately displayed concurrently with displaying the EPG selections.

Terakado discloses (**in the same field of endeavor**) a similar system which is capable of allowing a user to view a program broadcast on the television while concurrently viewing the EPG data on the remote terminal (**see Column 9, Lines 47-53**).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the systems of Ellis, Ellis ('926 Patent) and Yoshida, using the teachings of Terakado in order to provide a system capable of allowing a user to watch a broadcast program on the television receiver 9, while checking programs to be broadcast from a time onward by using an EPG without obstructing the display of the television receiver 9 (**see Column 9, Lines 50-53 of Terakado**).

Referring to claim 16, see the rejection of claim 8.



***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P. Salce whose telephone number is (571) 272-7301. The examiner can normally be reached on M-F 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason P Salce/  
Primary Examiner, Art Unit 2421

Jason P Salce  
Primary Examiner  
Art Unit 2421

January 26, 2009